

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ted Christopher

Examiner: Francis J. Jaworski

Serial No.: 08/746,360

Art Unit: 3737

Filed: November 8, 1996

Docket: 9872

For: FINITE AMPLITUDE DISTORTION-BASED INHOMOGENEOUS PULSE ECHO ULTRASONIC IMAGING

Dated: September 15, 2005

Confirmation No.: 7522

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

Sir:

This petition is responsive to the Determination of Patent Term Extension under 35 U.S.C. § 154(b), mailed 15 June 2005 together with the Notice of Allowance and Fees Due issued in the above-captioned application. That determination alleged that the instant application is entitled to zero (0) days' Patent Term Extension. Applicant respectfully traverses this determination and petitions for Patent Term Adjustment pursuant to 37 C.F.R. § 1.705. This petition is timely filed concurrently with the payment of the Issue Fee in this application, and the U.S. Patent and Trademark Office is authorized to charge the required \$200.00 Petition Fee, pursuant to 37 C.F.R. § 1.18(e), to Deposit Account No. 19-3886/RCT. A duplicate copy of this paper is enclosed.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 15, 2005.

Dated: September 15, 2005


John S. Sensny

I. Summary of Argument

Since the implementation of the 20-year patent term, measured from the earliest filing date, pursuant to the Uruguay Round Agreements on Trade Related Aspects of Intellectual Property (TRIPs), replacing the former measurement of patent term as 17 years from date of issue, Congress has repeatedly expressed its concern that absent unusual circumstances, no U.S. patent should have an enforceable term of less than 17 years. Towards that end, the Uruguay Round Agreements Act (URAA) implementing the 20-year term provided that patents then in force should have a term of the longer of 17 years from issue or 20 years from earliest filing. *See*, 35 U.S.C. § 154(c). The URAA also included provisions to compensate an applicant for certain delays, including those due to interference proceedings, secrecy orders, or successful appellate review of a rejection. Seeing these provisions as inadequate to address all instances of inequity due to delays in issuing a patent, Congress enacted the Patent Term Guarantee Act of 1999 (PTGA). The PTGA amended the patent term extension provisions to provide for an express guarantee of a 17-year term, and to expand the class of administrative delays for which an applicant could be compensated by patent term extension.

It is against this legislative background that the instant application stands in stark contrast. The instant application has been now pending over nine years, notwithstanding Applicant's diligent efforts to conclude prosecution. Some of the delays are simply inexplicable, and none are attributable to any dilatory effort or intent by Applicant. However, it is the Office's determination that by application of its regulations pertaining to patent term extension, the instant application is entitled to no term extension. Applicant submits that this determination is incorrect for at least two reasons.

First, the instant Application is entitled to Patent Term Extension as compensation for the delay due to a public use proceeding. Applicant will show that the public use proceeding has the hallmarks of an interference in structure, conduct, intent and effect. It should therefore be considered as an interference for purposes of Patent Term Extension provisions of the URAA.

Moreover, Applicant will show that in order to give full effect to the remedial intent of Congress in enacting the PTGA, that the class of patent applications, including the instant application, that were on file on the effective date of the PTGA must be treated under the revised provisions of 35 U.S.C. § 154(b). Accordingly, the instant application is entitled to the express guarantee of 17-year term, and term extension accordingly.

The facts in support of this petition are as follows.

II. Timeline of Prosecution Events

The instant application was filed 08 November 1996, and has been pending nearly nine (9) years. In that extraordinary amount of time that application has been delayed in prosecution for reasons that are often inexplicable, and are wholly unattributable to Applicant, and notwithstanding Applicant's diligent efforts to advance prosecution. A graphical timeline of the prosecution of this application is submitted herewith as Exhibit A.

A first office Action was issued in this case on 30 May 1997. On 20 March 1998 (Application pending 16 months) a petition to institute a Public Use Proceeding was filed by a third party, Acuson, Inc. Nearly 8 months later, 06 November 1998 (Application

pending 24 months), the Examiner issued a Memorandum that the petition to institute a public use proceeding had established a *prima facie* case. On 25 February 2000 (Application pending 39 months), nearly two years after the petition was first filed, the Office issued a decision granting the petition to institute a Public Use Proceeding.

The testimony period was closed and briefs filed in the Public Use Proceeding by 10 June 2001 (Application pending 4 years, 7 months). It was 21 months later, on 18 March 2003 (Application pending 6 years, 4 months), 3 years and 21 days (1,117 days) since the Petition to institute the Public Use Proceeding was granted, that the Examiner issued a decision favorable to the Applicant, i.e. that no public use of the claimed invention occurred.

It was an additional 27 months following the decision in the Public Use Proceeding, 15 June 2005 (Application pending 8 years 7 months) that the Office issued a Notice of Allowance. In the intervening time since the public use proceeding was closed favorably to the Applicant, Applicant filed two submissions and conducted two personal interviews with the Examiner in this case in an attempt to bring prosecution to a close. Presuming the Application issues on the Tuesday that is three and one-half months from the Issue Fee Due Date (i.e., 27 December 2005), it will have been pending nine (9) years and forty nine (49) days. Under the provisions of 35 U.S.C. § 154(a), it will expire 08 November 2016, with less than 11 years remaining of its 20-year term, and having surrendered over six years relative to the guaranteed 17-year term under 35 U.S.C. § 154(b)(1)(B).

III. Patent Term Extension Under the Uruguay Round Agreements Act (URAA)

The instant application is one of a class having filing dates between 08 June 1995 and 28 May 2000. The decision of the Director in *In re Patent No. 6,484,146* suggests that this class of applications are subject to § 532(a) of the URAA for the purposes of determining Patent Term Extension. *See*, 71 USPQ2d 1901, 1911 n.11 (Dir USPTO 2003). Section 532(a) of the URAA amended 35 U.S.C. § 154(b) to provide for patent term extension in the event the issue of a patent is delayed due to interference proceeding under § 135(a), secrecy order under § 181, or successful review by the Board of Patent Appeals and Interferences or a Federal Court. Patent Term Extension under § 154(b) was limited to five years.

Section 135(a) provides that the Board of Patent Appeals and Interferences shall decide questions of priority and may decide questions of patentability among a pending application and another pending application or unexpired patent. On the other hand, 37 C.F.R. § 1.292 provides for public use proceedings, such as were held in the instant application, to investigate whether a claimed invention is unpatentable for reason of prior public use or sale. Public use proceedings are complementary to interference proceedings, as see for example in 37 C.F.R. § 1.292(c) (Public use proceeding may not be requested by party to interference). For the following reasons, Applicant submits that the characteristics of the public use proceeding make it analogous to an interference proceeding for the purposes of Patent Term Extension under § 154(b). Therefore, Applicant is at least entitled to Patent Term Extension pursuant to § 154(b) as it existed at the time the instant application was filed.

Public use proceedings are not explicitly required by statute, but are a creation of the Director under his rulemaking authority. *See*, 35 U.S.C. § 2. Being such infrequent occurrences, it is not surprising that they are not specifically mentioned in the statute. However, their characteristic similarity to interferences are clear. Like a public use proceeding as to a pending application, an interference with a pending application may be requested by a third party. *See*, 37 C.F.R. §§ 1.292(a), 1.604(a). Both statute and regulations place the determination of the proceedings under the authority of the Director. *See*, 35 U.S.C. § 6 (Director *ex officio* member of the Board of Patent Appeals and Interferences); 37 C.F.R. § 1.292(a) (Director may designate an appropriate official to conduct the public use proceeding). The commencement of both proceedings is discretionary with the Director. *See*, 35 U.S.C. § 135(a) ("[A]n interference **may** be declared...") (emphasis added); 37 C.F.R. § 1.292(a) ("[A] hearing **may** be had before the Director to determine whether a public use proceeding should be instituted.") (emphasis added).

More importantly, both proceedings are fact-finding in nature. They both determine the existence of facts that would bar the grant of a patent to an applicant. In the case of an interference, the barring facts would be prior invention by another, 35 U.S.C. § 102(g). In the case of a public use proceeding, the barring facts would be prior public use or sale, 35 U.S.C. § 102(a), (b). However, section 135(a) permits the Board to determine patentability, and does not in any way limit the grounds on which patentability is to be determined. Finally both proceedings are outside the ordinary course of patent prosecution, and where the results of the proceedings do not bar the grant of a patent they present a significant delay to that grant. It is because of the length of

delay, and the inequity of penalizing the applicant for time consumed by an inquiry that ultimately does not prevent the grant of the patent, that term of such patents are extended by the number of days consumed by the delay.

Therefore, in light of the characteristic similarities between an interference proceeding and a public use proceeding, Applicant respectfully submits that a public use proceeding under 37 C.F.R. § 1.292 is, for purposes of Patent Term Extension under 35 U.S.C. § 154(b), an interference proceeding. Given the inequity of the delay in issuing the patent, it is a clear miscarriage of justice, and contrary to the intent of 35 U.S.C. § 154, not to grant the requested extension.

Accordingly, Applicant is entitled at least to Patent Term Extension as set forth in 37 C.F.R. § 1.701(c)(1)(i), calculated as the number of days beginning on the date that the proceeding was declared, and ending on the date that the proceeding was terminated. In the case of present Application, the Public Use Proceeding was declared on 25 February 2000 by the granting of the petition to institute the public use proceeding. It was terminated on 18 March 2003 with the Decision of the Examiner that no public use of the claimed invention occurred. The interval between these two dates is 1,117 days. Applicant respectfully claims entitlement to Patent Term Extension of at least 1,117 days. Term extension is calculated as three years (including one leap year) plus 21 days.

IV. Patent Term Extension Under the Patent Term Guarantee Act of 1999 (PTGA)

The present application also is entitled to a term extension under 35 U.S.C. § 154(b) as revised by the PTGA (PL 106-113, Nov. 29, 1999, 113 Stat 1501, 1501A-557).

Under PTGA § 4405, the revisions to 35 U.S.C. § 154(b) "[S]hall apply to any application filed on or after the date that is 6 months after the date of the enactment of this Act [29 May 2000]." Regulations issued implementing this statutory language, e.g., 37 C.F.R. Subpart F (§ 1.701 et. seq.), and decisions of the Director, *In re Patent No. 6,484,146*, 71 USPQ2d 1901, 1911 n.11 (Dir USPTO 2003), have implicitly interpreted that statutory language to apply to patent applications having a filing date that is on or after 29 May 2000. Applicant respectfully submits that this is a misinterpretation of the operative statutory language, and unduly limits its remedial effect. The Legislative mandate of applicability was to applications "filed on or after" 29 May 2000, which includes applications that were on file on or after 29 May 2000, i.e., including applications pending on that date.

While the Director has promulgated regulations based upon an erroneous interpretation of the statute, the Director's interpretation is not binding. The Federal Circuit has held that the Director is not vested with the authority to issue substantive rules, only to regulate the conduct of proceedings in the USPTO. *See, Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1550-51, 38 USPQ2d 1347 (Fed. Cir. 1996). Statutory language and intent must control. No court has yet had the opportunity to address the applicability of PTGA § 4402 to applications pending on 29 May 2000.

The language of the PTGA is mandatory, the revisions "shall apply". The only question is defining the class applications to which it applies. The House Conference Report accompanying HR 1554, which would be enacted as PL 106-113 including the PTGA, states that Congress recognized that the problem that under the revisions for patent term extension then in effect, "[N]o adjustments were provided for administrative

delays caused by the USPTO that were beyond the control of the applicant." *See*, H.R. CONF. REP. 106-464, *125. Earlier discussions of similar provisions of Patent Term Restoration in S. 507 recognized the same inequity. "It is still possible, however, that an individual patentee would have less patent term under the new term than under the old. To remedy this situation, title III [Patent Term Restoration] restores patent term lost to 'unusual administrative delay' by the PTO and guarantees all diligent applicants a minimum 17-year term... failure of the PTO to issue a patent to a diligent applicant within three years after the actual filing date is considered to be 'unusual administrative delay'." S. REP. 105-42, *54-55. In its final form, the House Conference report stated "[S]ection 154(b)(1)(B) guarantees a total application pendency of no more than three years. Specifically, day-for-day restoration of term is granted if the USPTO has not issued a patent within three years after 'the actual date of the application in the United States.'" H.R. CONF. REP. 106-464, *126.

Therefore, Congress clearly recognized the injustice of the serious, if infrequent situations identical to those in the present application, and sought to enact remedial measures. It is, however, inconceivable that Congress recognized a class of patent applications subject to such inequity, and crafted a solution to alleviate that inequity, yet specifically excluded those applications that induced Congress to act from sharing in the solution. The Senate Committee addressing Patent Term Restoration stated in its report "[T]he Patent Office should make every effort to ensure that the applicants whose patents are unfairly delayed receive appropriate restorations... should coordinate the restoration provisions to ensure that an applicant is, at all points, given the opportunity to meet the standards for compensation." S. REP. 105-42, *103.

Despite the broad remedial intent of the statute and the Congressional direction that it be broadly applied, the Director through rulemaking has adopted implementing regulations whereby patent applications on file on 29 May 2000, but having a filing date prior to 29 May 2000 are improperly denied compensatory Patent Term Extension. This is contrary to the intent and language of the controlling statute. Rather, a broad and inclusive reading of the statutory language should lead the Director to conclude that patent applications on file as of the effective date of the statute, 29 May 2000, are to be included among those "filed on or after" for the purposes of that provision. Accordingly, 35 U.S.C. § 154(b) as amended is applicable to the instant application, and the instant application is entitled to Patent Term Extension under its provisions.

Therefore, seeing that 35 U.S.C. § 154(b) as revised by the PTGA is applicable to the instant application, the number of days' adjustment must be determined. Under subsection (b)(1)(B), "[T]he term of the patent shall be extended 1 day for each day after the end of that 3-year period [after the actual filing of the application in the United States] until the patent is issued." The present application having a filing date of 08 November 1996, three years from that date is 06 November 1999. Presuming the present application issue on the Tuesday that is three and one-half months from the due date of the Issue Fee [27 December 2005], it is entitled to 2,241 days patent term extension. Term extension is calculated as six years (including two leap years) plus 49 days.

Applicant's additional argument that the public use proceeding in this application constitutes an interference under § 135(a) for the purposes of § 154(b) patent term extension does not alter the above calculation. Any reduction of patent term extension

attributable to the public use proceeding under § 154(b)(1)(B)(ii) would be recaptured under § 154(b)(1)(C)(i).

V. Conclusion

It can be seen from the foregoing that the instant application is entitled to patent term extension, at least in the amount of 1,117 days under the prior provisions of 35 U.S.C. § 154(b). However, contrary to the USPTO's erroneous interpretation and subsequent implementation of the PTGA, the instant application is entitled to treatment under 35 U.S.C. § 154(b) as amended, and accordingly is entitled to patent term extension in the amount of 2,241 days. Applicant kindly requests the Director to issue the patent to be granted on the instant application indicating the full patent term extension of 2,241 days.

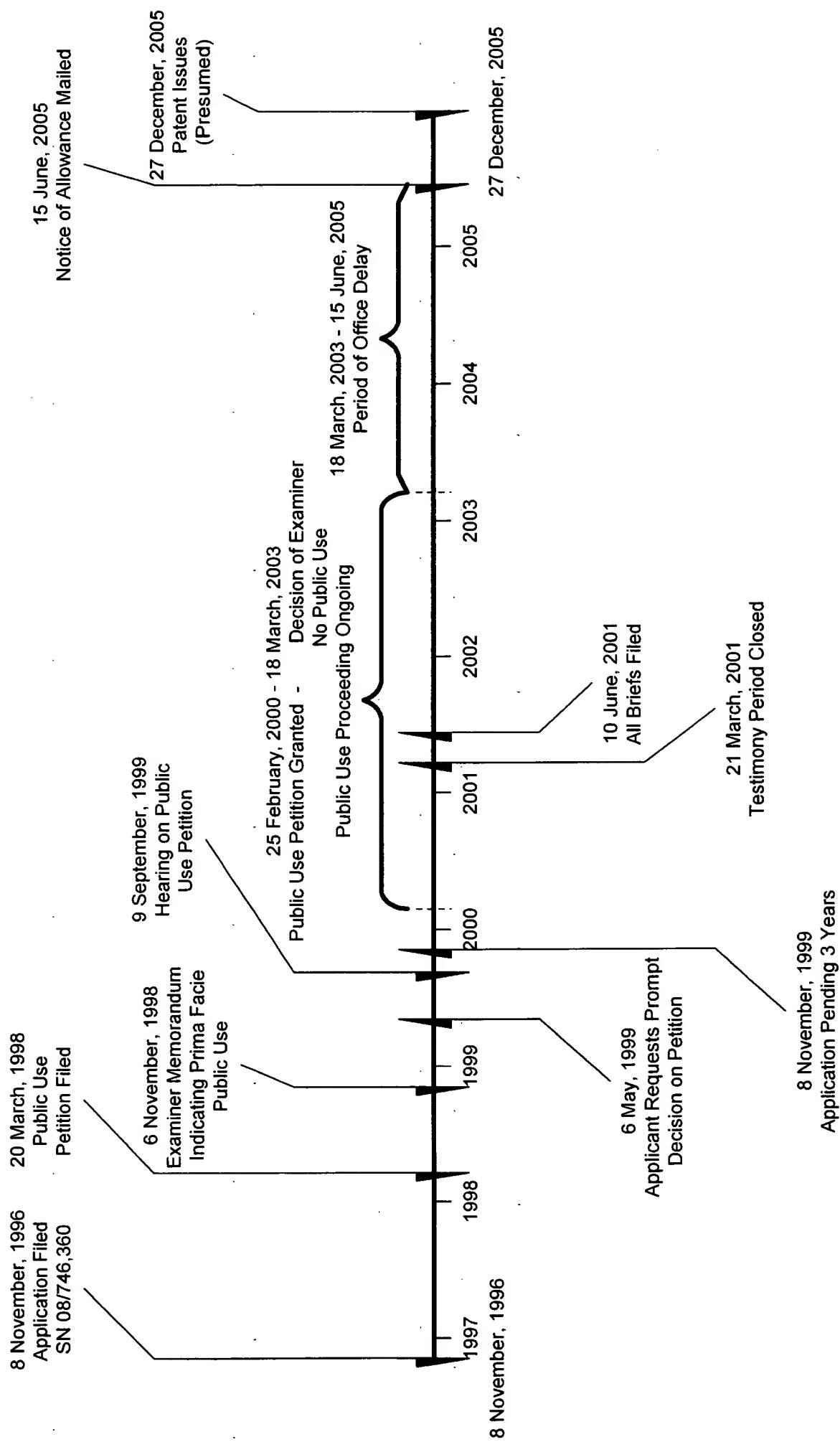
Respectfully Submitted,

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Enclosure: Exhibit A

EXHIBIT A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ted Christopher

Examiner: Francis J. Jaworski

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It is against this legislative background that the instant application stands in stark contrast. The instant application has been now pending over nine years, notwithstanding Applicant's diligent efforts to conclude prosecution. Some of the delays are simply inexplicable, and none are attributable to any dilatory effort or intent by Applicant. However, it is the Office's determination that by application of its regulations pertaining to patent term extension, the instant application is entitled to no term extension. Applicant submits that this determination is incorrect for at least two reasons.

First, the instant Application is entitled to Patent Term Extension as compensation for the delay due to a public use proceeding. Applicant will show that the public use proceeding has the hallmarks of an interference in structure, conduct, intent and effect. It should therefore be considered as an interference for purposes of Patent Term Extension provisions of the URAA.

Moreover, Applicant will show that in order to give full effect to the remedial intent of Congress in enacting the PTGA, that the class of patent applications, including the instant application, that were on file on the effective date of the PTGA must be treated under the revised provisions of 35 U.S.C. § 154(b). Accordingly, the instant application is entitled to the express guarantee of 17-year term, and term extension accordingly.

The facts in support of this petition are as follows.

II. Timeline of Prosecution Events

The instant application was filed 08 November 1996, and has been pending nearly nine (9) years. In that extraordinary amount of time that application has been delayed in prosecution for reasons that are often inexplicable, and are wholly unattributable to Applicant, and notwithstanding Applicant's diligent efforts to advance prosecution. A graphical timeline of the prosecution of this application is submitted herewith as Exhibit A.

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III. Patent Term Extension Under the Uruguay Round Agreements Act (URAA)

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Section 135(a) provides that the Board of Patent Appeals and Interferences shall decide questions of priority and may decide questions of patentability among a pending application and another pending application or unexpired patent. On the other hand, 37 C.F.R. § 1.292 provides for public use proceedings, such as were held in the instant application, to investigate whether a claimed invention is unpatentable for reason of prior public use or sale. Public use proceedings are complementary to interference proceedings, as see for example in 37 C.F.R. § 1.292(c) (Public use proceeding may not be requested by party to interference). For the following reasons, Applicant submits that the characteristics of the public use proceeding make it analogous to an interference proceeding for the purposes of Patent Term Extension under § 154(b). Therefore, Applicant is at least entitled to Patent Term Extension pursuant to § 154(b) as it existed at the time the instant application was filed.

Public use proceedings are not explicitly required by statute, but are a creation of the Director under his rulemaking authority. *See*, 35 U.S.C. § 2. Being such infrequent occurrences, it is not surprising that they are not specifically mentioned in the statute. However, their characteristic similarity to interferences are clear. Like a public use proceeding as to a pending application, an interference with a pending application may be requested by a third party. *See*, 37 C.F.R. §§ 1.292(a), 1.604(a). Both statute and regulations place the determination of the proceedings under the authority of the Director. *See*, 35 U.S.C. § 6 (Director *ex officio* member of the Board of Patent Appeals and Interferences); 37 C.F.R. § 1.292(a) (Director may designate an appropriate official to conduct the public use proceeding). The commencement of both proceedings is discretionary with the Director. *See*, 35 U.S.C. § 135(a) ("[A]n interference **may** be declared...") (emphasis added); 37 C.F.R. § 1.292(a) ("[A] hearing **may** be had before the Director to determine whether a public use proceeding should be instituted.") (emphasis added).

More importantly, both proceedings are fact-finding in nature. They both determine the existence of facts that would bar the grant of a patent to an applicant. In the case of an interference, the barring facts would be prior invention by another, 35 U.S.C. § 102(g). In the case of a public use proceeding, the barring facts would be prior public use or sale, 35 U.S.C. § 102(a), (b). However, section 135(a) permits the Board to determine patentability, and does not in any way limit the grounds on which patentability is to be determined. Finally both proceedings are outside the ordinary course of patent prosecution, and where the results of the proceedings do not bar the grant of a patent they present a significant delay to that grant. It is because of the length of

delay, and the inequity of penalizing the applicant for time consumed by an inquiry that ultimately does not prevent the grant of the patent, that term of such patents are extended by the number of days consumed by the delay.

Therefore, in light of the characteristic similarities between an interference proceeding and a public use proceeding, Applicant respectfully submits that a public use proceeding under 37 C.F.R. § 1.292 is, for purposes of Patent Term Extension under 35 U.S.C. § 154(b), an interference proceeding. Given the inequity of the delay in issuing the patent, it is a clear miscarriage of justice, and contrary to the intent of 35 U.S.C. § 154, not to grant the requested extension.

Accordingly, Applicant is entitled at least to Patent Term Extension as set forth in 37 C.F.R. § 1.701(c)(1)(i), calculated as the number of days beginning on the date that the proceeding was declared, and ending on the date that the proceeding was terminated. In the case of present Application, the Public Use Proceeding was declared on 25 February 2000 by the granting of the petition to institute the public use proceeding. It was terminated on 18 March 2003 with the Decision of the Examiner that no public use of the claimed invention occurred. The interval between these two dates is 1,117 days. Applicant respectfully claims entitlement to Patent Term Extension of at least 1,117 days. Term extension is calculated as three years (including one leap year) plus 21 days.

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Therefore, Congress clearly recognized the injustice of the serious, if infrequent situations identical to those in the present application, and sought to enact remedial measures. It is, however, inconceivable that Congress recognized a class of patent applications subject to such inequity, and crafted a solution to alleviate that inequity, yet specifically excluded those applications that induced Congress to act from sharing in the solution. The Senate Committee addressing Patent Term Restoration stated in its report "[T]he Patent Office should make every effort to ensure that the applicants whose patents are unfairly delayed receive appropriate restorations... should coordinate the restoration provisions to ensure that an applicant is, at all points, given the opportunity to meet the standards for compensation." S. REP. 105-42, *103.

Despite the broad remedial intent of the statute and the Congressional direction that it be broadly applied, the Director through rulemaking has adopted implementing regulations whereby patent applications on file on 29 May 2000, but having a filing date prior to 29 May 2000 are improperly denied compensatory Patent Term Extension. This is contrary to the intent and language of the controlling statute. Rather, a broad and inclusive reading of the statutory language should lead the Director to conclude that patent applications on file as of the effective date of the statute, 29 May 2000, are to be included among those "filed on or after" for the purposes of that provision. Accordingly, 35 U.S.C. § 154(b) as amended is applicable to the instant application, and the instant application is entitled to Patent Term Extension under its provisions.

Therefore, seeing that 35 U.S.C. § 154(b) as revised by the PTGA is applicable to the instant application, the number of days' adjustment must be determined. Under subsection (b)(1)(B), "[T]he term of the patent shall be extended 1 day for each day after the end of that 3-year period [after the actual filing of the application in the United States] until the patent is issued." The present application having a filing date of 08 November 1996, three years from that date is 06 November 1999. Presuming the present application issue on the Tuesday that is three and one-half months from the due date of the Issue Fee [27 December 2005], it is entitled to 2,241 days patent term extension. Term extension is calculated as six years (including two leap years) plus 49 days.

Applicant's additional argument that the public use proceeding in this application constitutes an interference under § 135(a) for the purposes of § 154(b) patent term extension does not alter the above calculation. Any reduction of patent term extension

attributable to the public use proceeding under § 154(b)(1)(B)(ii) would be recaptured under § 154(b)(1)(C)(i).

V. Conclusion

It can be seen from the foregoing that the instant application is entitled to patent term extension, at least in the amount of 1,117 days under the prior provisions of 35 U.S.C. § 154(b). However, contrary to the USPTO's erroneous interpretation and subsequent implementation of the PTGA, the instant application is entitled to treatment under 35 U.S.C. § 154(b) as amended, and accordingly is entitled to patent term extension in the amount of 2,241 days. Applicant kindly requests the Director to issue the patent to be granted on the instant application indicating the full patent term extension of 2,241 days.

Respectfully Submitted,

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Enclosure: Exhibit A

EXHIBIT A

